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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,034	12/14/2000	Werner Obrecht	Mo-5842/LeA 34,092	4130

157 7590 06/16/2004

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EXAMINER	
SERGENT, RABON A	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/739,034	OBRECHT ET AL.	
	Examiner	Art Unit	
	Rabon Sergent	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-10,15,20 and 21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-10,15,20 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 1, 2, 4-10, 15, 20, and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Within pages 7 and 8 of the response of September 17, 2003, applicants have stated that the pending claims are clearly directed to rubbers (component A) that are not in the "latex" form. To support their position, applicants have provided a 37 CFR 1.132 declaration, executed by Dr. Werner Obrecht, stating that component A is not a liquid rubber and have referred to ISO 1629 to argue that the nomenclature for a liquid rubber has not been used within the specification. These arguments have been considered; however, they do little to explain the fact that applicants state a page 10, lines 28+ that the rubber mixtures "may ... be prepared from the latexes of the rubber component (A) ...". Without further explanation, this language clearly indicates that the use of component (A) in liquid form was contemplated by applicants, and it is further reasonable to conclude that the claims encompass such a liquid component, despite applicants' response. Since applicants' response and the specification are contradictory, the specification and claims fail to comply with the written description requirement of 35 U.S.C. 112, first paragraph. Furthermore, this issue must be resolved since it has a direct bearing on distinguishing the claims from the prior art.

2. Applicants' response of March 25, 2004 has merely set forth the differences between latex and liquid rubber. Accordingly, applicants' response has in no way addressed the aforementioned contradiction between applicants' response of September

17, 2003 that component A is not a latex and the specification at page 10, lines 28+ stating that the rubber mixtures "may ... be prepared from the latexes of the rubber component (A) ...". The position is taken that the resolution of this contradiction is critical in determining the scope of the claims and the meaning of the claim terminology, because, on one hand, the record (specification) states that the claim terminology encompasses latexes and, on the other hand, the record (applicants' response) states that the same claim terminology does not encompass latexes.

3. As aforementioned, applicants' response is primarily concerned with setting forth the differences between latex and liquid rubber and has apparently been set forth, because applicants consider that the examiner maintains that component (A) is a liquid rubber. Firstly, it is not seen how this response clarifies the aforementioned contradiction. The arguments in no way clarify what is encompassed by the claims. Secondly, applicants' argument with respect to the examiner's position is incorrect. The examiner has not argued that the claims encompass liquid rubber; rather, the examiner has stated, "... the use of component (A) in ***liquid form*** was contemplated by applicants, and it is further reasonable to conclude that the claims encompass such a ***liquid component***, ...". The examiner has carefully chosen the terms, "liquid form" and "liquid component", so as to encompass any rubber component which is associated with the liquid state, whether it be liquid rubber or latex. This was done in view of applicants' inconsistent and interchangeable use of the terms, latex and liquid rubber. Note that the response of September 17, 2003 argues that component (A) is not in the latex form; however, the declaration to support this position states that liquid rubber is not used within the specification. Upon reading the response and declaration, one can only assume that

applicants are using the terms interchangeably. Applicants' statement of the differences between latex and liquid rubber further fail to clarify this additional inconsistency between the response of September 17, 2003 and the declaration in support thereof.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

RABON SERGENT
PRIMARY EXAMINER

R. Sergent

June 8, 2004